

36. (New) The combination of claim 29, wherein said first and second ramp segments are elastomeric.

~~37. (New) The combination of claim 36 wherein said first and second ramp segments include a core of rigid and relatively heavy material.~~

~~38. (New) The combination of claim 37 wherein said core is metal.~~

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39. (New) The combination of claim 29, wherein said first and second ramp segments further comprise fastener openings for receiving fasteners therethrough to secure said first and second ramp segments to the roadway while in use.

~~40. (New) The combination of claim 25, wherein said first ramp segments include a hinge mechanism to allow said first ramp segments to fold between a first closed folded position and second open position.~~

~~41. (New) The combination of claim 29, wherein said first and second ramp segments include a hinge mechanism to allow said first and second ramp segments to fold between a first closed folded position and second open position.~~

REMARKS

Claims 2-24 have been cancelled, therefore the Office's rejections under 35 U.S.C. § 112, second paragraph with respect to indefiniteness and proper antecedent basis are now moot.

Before addressing the Office's Section 103(a) rejections over the cited references, Applicant desires to clarify that independent claim 25 is intended to include within its scope both (1) temporary protective ramps for substantially circular elevated obstructions (such as manholes and other circular utility access holes), as well as (2) temporary protective ramps for other non-

circular elevated obstructions (such as rectangular utility access holes, and adjacent roadway sections under construction).

It is believed new claims 25-41 overcome the Office's Section 103(a) obviousness rejections in the December 19, 2001 Office Action for the reasons identified below.

The Office rejected the now cancelled “[c]laims 24, 2-7, 9 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Shaftner (U.S. Patent 5,308,188) in view of Rech (U.S. Patent 4,373,306). Office Action, p. 2. Specifically, the Office asserts that:

Shaftner discloses the claimed device except for providing segments with male/female mating shapes. Rech discloses that it is known in the art to provide the device in segments having mating shapes . . . in order to make the device portable for temporary use in the desired form needed at the time of construction. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the ramp of Shaftner with the sections of Rech, in order to make the device portable for temporary use in the desired form needed at the time of construction.

Office Action, p. 3.

Applicant respectfully asserts that the Office is improperly using hindsight to combine the teachings of Shaftner and Rech.

“When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.” Id. at 1343. Shaftner discloses a single piece “protective ramp for placement around a temporarily elevated underground utility access hole support.” Shaftner, ABSTRACT. There is no teaching, motivation or suggestion in Shaftner that the single-piece temporary ramp could be cut or sectioned into segments to make the device more portable such that a single person may carry and install the segments. Nor is there any teaching, motivation or suggestion in Shaftner to provide coupling formations for interlocking adjacently disposed edges of the ramp segments.

Applicant does not dispute that Rech discloses an assembly of adjacently disposed, removably interlocking segments to form a deck or platform with at least one inclined side to allow vehicles to more easily drive up onto the deck assembly. See Rech, Fig. 1. Rech, however, does not provide any teaching, motivation or suggestion of providing a temporary protective

ramp for positioning adjacent an elevated obstruction on a roadway surface under construction such that vehicles traveling on the roadway ride up and over the elevated obstruction without damage.

Therefore, there is no objective evidence of record which provides the necessary teaching, motivation or suggestion to combine the teachings of Shaftner with the teachings of Rech to make the claimed invention. With all due respect, the Office cannot simply make the unsupported, conclusory assertion that one of ordinary skill in the art would have been motivated to cut or segment the ramp of Shaftner in order to make the device more portable and easier to handle by a single person and to further form interlocking formations in adjacent edges simply because Rech discloses "interfitting structural elements" of a deck or platform. Before the Office can properly combine these two references, the Office must first identifying and articulating the objective evidence in these references to make such a combination. As stated, however, it is submitted that there is no such objective evidence in these references for combining their teachings and therefore the Office is improperly using hindsight in arriving at its obviousness rejection. As held by the Federal Circuit:

"The factual inquiry whether to combine references must be thorough and searching." It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'") (quoting C.R. Bard, Inc., v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984))).

The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be

made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

In re Lee, 277 F.3d at 1343.

The Office cannot simply assert that the combination of the teachings of Shaftner and Rech is within the general knowledge of one skilled in the art to negate patentability of the claimed invention without articulating and placing the basis of that alleged knowledge into the record. As held by the Federal Circuit:

[W]hen they [the patent examiner and the board] rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

Id.

"This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to '[use] that which the inventor taught against its teacher.'" Id. at 1343-44 (quoting W.L. Gore, 721 F.2d at 1553, 220 USPQ at 312-13).

The Office's 103(a) obviousness rejections of cancelled claims 8, 11 and 13-18 (directed to a temporary ramp with a metal core) as being unpatentable over Shaftner in view of Rech and further in view of McGinnis should likewise be withdrawn as to new claims 33-34 and 37-38 for the reasons identified above.

The Office's 103(a) obviousness rejections of cancelled claims 12, 21 and 22 (directed to a temporary ramp with a hinge mechanism) as being unpatentable over Shaftner in view of Rech and further in view of Poe should likewise be withdrawn as to new claims 40 and 41 for the reasons identified above.

The Office's 103(a) obviousness rejections of cancelled claims 19, 20 and 23 (directed to a temporary ramp with a fastener) as being unpatentable over Shaftner in view of Rech and further in view of McGinnis and further in view of Poe should likewise be withdrawn as to new claims 35 and 39 for the reasons identified above.

For the foregoing reasons, it is respectfully submitted that claims 25-41 are in a condition for allowance and that Offices obviousness rejections should be withdrawn.

Respectfully submitted,

Earl D. Koch

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By: 

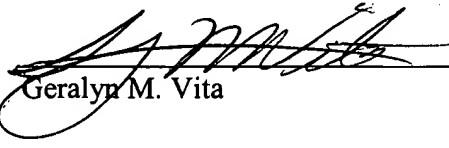
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Pursuant to 37 CFR 1.10, I hereby certify that this Amendment in U.S. Application Serial No. 09/553,492, is being deposited with the U.S. Postal Service by Express Mail, Post Office to Addressee service, addressed to: Commissioner for Patents, Washington, D.C. 20231, on the date of deposit and under the mailing label number indicated below.

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